

Remarks

The Office Action mailed August 25, 2004 has been carefully reviewed and the following remarks have been made in consequence thereof.

Claims 1-22 are now pending in this application. Claims 1-22 stand rejected.

In accordance with 37 C.F.R. 1.136(a), a three month extension of time is submitted herewith to extend the due date of the response to the Office Action dated August 25, 2004, for the above-identified patent application from November 25, 2004, through and including February 25, 2005. In accordance with 37 C.F.R. 1.17(a)(3), authorization to charge a deposit account in the amount of \$ 1020.00 to cover this extension of time request also is submitted herewith.

The rejection of Claims 1-22 under 35 U.S.C. § 103 as being unpatentable over Geschwender et al. (U.S. Patent No. 5,038,606) ("Geschwender") is respectfully traversed.

Geschwender describes a rain gauge 10 having an interface means 12, a container 14, a mounting bracket 16, and a float 18. Container 14 includes an open top for receiving interface means 12. Specifically, interface means 12 includes a top opening 30 having a first diameter and a bottom opening having a second diameter that is slightly smaller than the diameter of container 14. Between interface opening 30 and the bottom of interface means 12 is a first cylindrical tubular member 32, a second frusto conical member 34 which slopes inwardly in a funnel like manner, a third lower smaller diameter cylindrical member 36 sized to fit within the inner diameter of container 14 and a final terminating cylinder 38 that is slightly smaller than the third smaller diameter cylindrical member 36. During use, rain is captured by interface means 12 and funneled into container 14. Specifically, because interface means 12 is received within container, all of the rain captured by interface means 12 is channeled into container 14.

Applicant respectfully submits that the Section 103 rejection of the presently pending claims is not a proper rejection. As is well established, the mere assertion that it would have

been obvious to one of ordinary skill in the art to have modified Geschwender to obtain the claimed recitations of the present invention does not support a *prima facia* obvious rejection. Rather, each allegation of what would have been an obvious matter of design choice must always be supported by citation to some reference work recognized as standard in the pertinent art and the Applicant given the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference. Applicant has not been provided with the citation to any reference supporting the combination made in the rejection. The rejection, therefore, fails to provide the Applicant with a fair opportunity to respond to the rejection, and fails to provide the Applicant with the opportunity to challenge the correctness of the rejection.

Moreover, obviousness cannot be established by merely suggesting that it would have been an obvious to one of ordinary skill in the art to modify Geschwender. As explained by the Federal Circuit, “to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the Applicant.” In re Kotzab, 54 USPQ2d 1308, 1316 (Fed. Cir. 2000). MPEP 2143.01.

Furthermore, as is well established, the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See In re Gordon, 221 U.S.P.Q.2d 1125 (Fed. Cir. 1984).

Furthermore, the Federal Circuit has determined that:

[I]t is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.”

In re Fitch, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). Further, under Section 103, “it is impermissible . . . to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” In re Wesslau, 147

USPQ 391, 393 (CCPA 1965). Rather, there must be some suggestion, outside of Applicants' disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicants' disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion nor motivation to combine the cited art, nor any reasonable expectation of success has been shown.

Accordingly, since there is no teaching nor suggestion in the cited art for the claimed combination, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicant requests that the Section 103 rejection of Claims 1-22 be withdrawn.

Moreover, if art "teaches away" from a claimed invention, such a teaching supports the nonobviousness of the invention. U.S. v. Adams, 148 USPQ 479 (1966); Gillette Co. v. S.C. Johnson & Son, Inc., 16 USPQ2d 1923, 1927 (Fed. Cir. 1990). In light of this standard, it is respectfully submitted that the cited art, as a whole, is not suggestive of the presently claimed invention. Specifically, Applicant respectfully submits that Geschwender teaches away from the present invention and as such, thus supports the nonobviousness of the present invention. More specifically, Geschwender clearly describes a rain gauge and a mounting bracket for supporting the rain gauge. As such, the presently pending claims are patentably distinguishable from Geschwender.

In addition, and to the extent understood, Geschwender does not describe nor suggest the claimed combination. Specifically, Claim 1 recites a rain gauge assembly including "a first hollow cylinder having a side wall and a bottom wall closing a first end of said first cylinder, said first cylinder open at a second end and having an outside diameter...a second hollow cylinder having a side wall and a bottom wall closing a first end of said second cylinder, said second cylinder open at a second end and having an inside diameter approximately equal to said outside diameter of said first cylinder so that said first cylinder is receivable in said second cylinder, said second cylinder having a length that is less than a

length of said first cylinder, said first and second cylinders molded from a resilient translucent plastisol material...a means for attaching said second cylinder to a surface."

Geschwender does not describe nor suggest a rain gauge assembly as recited in Claim 1. More specifically, Geschwender does not describe nor suggest a second hollow cylinder having a side wall and a bottom wall closing a first end of the second cylinder. Moreover, Geschwender does not describe nor suggest a second cylinder having an inside diameter approximately equal to an outside diameter of a first cylinder so that the first cylinder is receivable in the second cylinder. Rather, in contrast to the present invention, Geschwender describes an interface means received in a tubular container and functioning as a funnel to capture rain water and channel the rain water into the container. Notably, the interface means described in Geschwender does not include a bottom wall closing a first end of the interface means. In contrast, the bottom portion of the interface means is open to allow the water captured by interface means to be channeled into the container. Moreover, the interface means described in Geschwender includes a bottom portion having a smaller diameter than the tubular container such that the interface means can be inserted into the container. Notably, the rain gauge described in Geschwender would function improperly if the interface means received the container, as a portion of the water captured by the interface means would be channeled outside of the container and thus be lost. Accordingly, for at least the reasons set forth above, Applicant respectfully submits that Claim 1 is patentable over Geschwender.

Claims 2-7 depend from independent Claim 1. When the recitations of Claims 2-7 are considered in combination with the recitations of Claim 1, Applicant submits that dependent Claims 2-7 likewise are patentable over Geschwender.

Claim 8 recites a rain gauge assembly including "a collection tube comprising a side wall and a bottom wall closing a first end of said collection tube, said collection tube open at a second end...a cap member comprising an open end and a closed end, and sized to fit over and cover an end of said collection tube, said collection tube and said cap member molded from a resilient translucent plastisol material...a means of attaching said cap member to a surface."

Geschwender does not describe nor suggest a rain gauge assembly as recited in Claim 8. More specifically, Geschwender does not describe nor suggest a cap member including an open end and a closed end, and sized to fit over and cover an end of a collection tube. Rather, in contrast to the present invention, Geschwender describes an interface means received in a tubular container and functioning as a funnel to capture rain water and channel the rain water into the container. Notably, the interface means described in Geschwender does not include a closed end. In contrast, the bottom portion of the interface means is open to allow the water captured by interface means to be channeled into the container. Moreover, the interface means described in Geschwender is not sized to fit over and **cover** an end of a collection tube. Accordingly, for at least the reasons set forth above, Applicant respectfully submits that Claim 8 is patentable over Geschwender.

Claims 9-14 depend from independent Claim 8. When the recitations of Claims 9-14 are considered in combination with the recitations of Claim 8, Applicant submits that dependent Claims 9-14 likewise are patentable over Geschwender.

Claim 15 recites a rain gauge kit including “a collection tube comprising a side wall and a bottom wall closing a first end of said collection tube, said collection tube open at a second end...a cap comprising an open end and a closed end, and sized to fit over and cover an end of said collection tube, said collection tube and said cap molded from a resilient translucent plastisol material...at least one of a fastener and a stake for attaching said cap to a surface.”

Geschwender does not describe nor suggest a rain gauge kit as recited in Claim 15. More specifically, Geschwender does not describe nor suggest a cap including an open end and a closed end, and sized to fit over and cover an end of a collection tube. Rather, in contrast to the present invention, Geschwender describes an interface means received in a tubular container and functioning as a funnel to capture rain water and channel the rain water into the container. Notably, the interface means described in Geschwender does not include a closed end. In contrast, the bottom portion of the interface means is open to allow the water captured by interface means to be channeled into the container. Moreover, the interface

means described in Geschwender is not sized to fit over and **cover** an end of a collection tube. Accordingly, for at least the reasons set forth above, Applicant respectfully submits that Claim 15 is patentable over Geschwender.

Claims 16-18 depend from independent Claim 15. When the recitations of Claims 16-18 are considered in combination with the recitations of Claim 15, Applicant submits that dependent Claims 16-18 likewise are patentable over Geschwender.

Claim 19 recites a method of fabricating a rain gauge assembly, wherein the method includes “molding a collection tube from a resilient translucent plastisol material...molding a cap from the translucent plastisol material...the collection tube comprising a side wall and a bottom wall closing a first end of the collection tube, the collection tube open at a second end...the cap comprising an open end and a closed end, and sized to fit over and cover an end of the collection tube.”

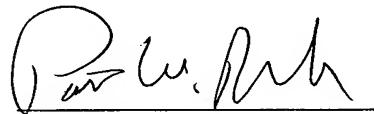
Geschwender does not describe nor suggest a method as recited in Claim 19. More specifically, Geschwender does not describe nor suggest molding a cap wherein the cap including an open end and a closed end, and sized to fit over and cover an end of a collection tube. Rather, in contrast to the present invention, Geschwender describes an interface means received in a tubular container and functioning as a funnel to capture rain water and channel the rain water into the container. Notably, the interface means described in Geschwender does not include a closed end. In contrast, the bottom portion of the interface means is open to allow the water captured by interface means to be channeled into the container. Moreover, the interface means described in Geschwender is not sized to fit over and **cover** an end of a collection tube. Accordingly, for at least the reasons set forth above, Applicant respectfully submits that Claim 19 is patentable over Geschwender.

Claims 20-22 depend from independent Claim 19. When the recitations of Claims 20-22 are considered in combination with the recitations of Claim 19, Applicant submits that dependent Claims 20-22 likewise are patentable over Geschwender.

For the reasons set forth above, Applicant respectfully requests that the Section 103 rejection of Claims 1-22 be withdrawn

In view of the foregoing amendments and remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,



Patrick W. Rasche
Registration No. 37,916
ARMSTRONG TEASDALE LLP
One Metropolitan Square, Suite 2600
St. Louis, Missouri 63102-2740
(314) 621-5070